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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,754	10/15/2001	Roger Nitsch	P66566USO	9987

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EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 12/20/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/831,754

Applicant(s)

NITSCH ET AL.

Examiner

Olga N. Chernyshev

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 39-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 39-76 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 39-54, drawn to an isolated nucleic acid encoding a protein, the protein encoded thereby and a method of producing a nucleic acid.

Group II, claim(s) 55-56, drawn to an antibody.

Group III, claim(s) 57-58, drawn to a method of detecting pathological cells.

Group IV, claim(s) 59-65, in so far as they are drawn to a method including determination of a level or activity of a nucleic acid.

Group V, claim(s) 59-65, in so far as they are drawn to a method including determination of a level or activity of a protein.

Group VI, claim(s) 59-65, in so far as they are drawn to a method including determination of a level or activity of a molecule affecting a level of a nucleic acid.

Group VII, claim(s) 59-65, in so far as they are drawn to a method including determination of a level or activity of a molecule affecting a level of a protein.

Group VIII, claim(s) 66-72, in so far as they are drawn to an agent which affects an activity of a nucleic acid.

Group IX, claim(s) 66-72, in so far as they are drawn to an agent which affects an activity of a protein.

Group X, claim(s) 66-72, in so far as they are drawn to an agent which affects an activity of a molecule which affects a level of activity of a nucleic acid.

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Group XI, claim(s) 66-72, in so far as they are drawn to an agent which affects an activity of a molecule which affects a level of activity of a protein.

Group XII, claim(s) 73-75, in so far as they are drawn to a method of identifying an agent by using a sample consisting of a nucleic acid.

Group XIII, claim(s) 73-75, in so far as they are drawn to a method of identifying an agent by using a sample consisting of a protein.

Group XIV, claim(s) 73-75, in so far as they are drawn to a method of identifying an agent by using a sample consisting of a molecule affecting a level of a nucleic acid.

Group XV, claim(s) 73-75, in so far as they are drawn to a method of identifying an agent by using a sample consisting of a molecule affecting a level of a protein.

Group XVI, claim(s) 76, in so far as it is drawn to a kit comprising a reagent that selectively detects a nucleic acid.

Group XVII, claim(s) 76, in so far as it is drawn to a kit comprising a reagent that selectively detects a protein.

Group XVIII, claim(s) 76, in so far as it is drawn to a kit comprising a reagent that selectively detects a molecule which affects a level of activity of a nucleic acid.

Group XIX, claim(s) 76, in so far as it is drawn to a kit comprising a reagent that selectively detects a molecule which affects a level of activity of a protein.

2. The inventions listed as Groups I-XIX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Pursuant to 37 C.F.R. § 1.475 (d), the ISA/US considers that where multiple products and processes are claimed, the main invention shall consist of the first invention of the category first mentioned in the claims and the first recited invention of each of the other categories related thereto. Accordingly, the main invention (Group I) comprises the first recited product, a nucleic acid encoding a protein, the protein, a method of making the nucleic acid and the first method of

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using the nucleic acid. Pursuant to 37 C.F.R. § 1.475 (d), the ISA/US considers that any feature which is the subsequently recited products and methods share with the main invention does not constitute a special technical feature within the meaning of PCT Rule 13.2 and that each of such products and methods accordingly defines a separate invention. Inventions of Groups III-VII and XII-XV are patentably distinct because they are directed to different methods that recite structurally and functionally distinct elements, are not required one for the other, achieve different goals, and therefore constitute patentably distinct inventions. Inventions of Groups II, VIII-XI and XVI-XIX are independent and distinct because they recite different molecular embodiments, which can be made and used independently without each other.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 782-9306 for regular communications and (703) 782-9307 for After Final communications.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Olga N. Chernyshev, Ph.D.  
December 16, 2002

*OC*



JOHN ULM  
PRIMARY EXAMINER  
GROUP 185